

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed April 22, 2008. At the time of the Final Office Action, Claims 54-70 were pending in this Application. Claims 54-70 were rejected. Claim 55 was objected to. Claims 54, 55, 65, and 70 have been amended to further define the claimed invention. Applicants respectfully request reconsideration and favorable action in this case.

### Claim Objections

Claim 55 was objected to by the Examiner because of informalities. Applicants amend claim 55 to overcome this objection and respectfully request full allowance of claim 55 as amended.

### Rejections under 35 U.S.C. §103

Claims 54-56 and 59-70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,682,596 issued to Bales et al. ("Bales"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 57-58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bales in view of GB 2037167 issued to Herczog et al. ("Herczog"). Applicants respectfully traverse. Claims 57 and 58 depend from Claim 54. As discussed above, Bales does not teach a hemispherical electrode surface. Similarly, Herczog also fails to teach or disclose a hemispherical electrode surface.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). With regard to claim 54, Applicants have amended the claim to now describe that the electrically conductive fluid is delivered at the distal end of the electrode terminal. Further, amended claim 54 now describes that that electrically conductive fluid provides a conductive path between the electrode terminal and the return electrode. Finally, the electrode terminal is now described as having an active electrode surface consisting of a hemispherical geometry. Bales does not teach a surgical instrument wherein electrically conductive fluid is

delivered at the distal end of an electrode terminal, and wherein the electrically conductive fluid provides a conductive path between the electrode terminal and a return electrode. Moreover, by amending claim 54 to now recite that the electrode terminal has an active electrode surface consisting of hemispherical geometry, Applicants have more clearly defined the electrode terminal in a way that addresses the Examiner's statement that the teachings of Bales disclose a hemispherical shaped electrode terminal. More specifically, that the teachings of Bales describe an electrode member 86 that "looks to be half a sphere, or at least a portion of (86) could be half a sphere" is not sufficient to teach the scope the electrode terminal now described in amended claim 54.

Therefore, Bales does not teach every element of claim 54 as amended, and cannot render obvious amended claim 54. Further, claims 55-56 and 59-64 depend either directly or indirectly from claim 54. For claims 55-56 and 59-64, Applicants hereby repeat and incorporate the comments above with regard to amended claim 54. Applicants respectfully submit that amended claim 54, and dependent claims 55-56 and 59-64 are in condition for allowance and request withdrawal of the rejection.

With regard to claim 65, Applicants repeat and hereby incorporate the comments made above with regard to amended claim 54. Specifically, Applicants submit that Bales does not teach a surgical instrument wherein electrically conductive fluid is delivered at the distal end of an electrode terminal, and wherein the electrically conductive fluid provides a conductive path between the electrode terminal and a return electrode. Further, Bales does not teach the scope of amended claim 65 with regard to the electrode terminal given that claim 65 now recites that the electrode terminal consists of a hemispherical-shaped active electrode surface. Therefore, Bales does not teach every element of claim 65 as amended, and cannot render obvious amended claim 65. Further, claims 66-69 depend either directly or indirectly from claim 65. For claims 66-69, Applicants hereby repeat and incorporate the comments above with regard to amended claim 65. Applicants respectfully submit that amended claim 65, and dependent claims 66-69 are in condition for allowance and request withdrawal of the rejection.

With regard to claim 70, Applicants repeat and hereby incorporate the comments made above with regard to amended claim 54 and 65. Specifically, Applicants submit that Bales does not teach an electrosurgical system wherein the electrically conductive fluid provides a conductive path between the electrode terminal and a return electrode. Further, Bales does not

teach the scope of amended claim 70 with regard to the electrode terminal given that claim 70 now recites that the electrode terminal consists of a hemispherical-shaped active electrode surface. Therefore, Bales does not teach every element of claim 70 as amended, and cannot render obvious amended claim 70. Applicants respectfully submit that amended claim 70 is in condition for allowance and request withdrawal of the rejection.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS and any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
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6/23/08

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- Enclosure:    1)      Information Disclosure Statement and PTO Form 1449, with copies of  
                         the references.  
                         2)      Supplemental Application Data Sheet